



3510-16-P

## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

#### Third-Party Submissions and Protests

**ACTION:** Proposed collection; comment request.

**SUMMARY:** The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on a proposed extension of an existing information collection: 0651-0062 (Third-Party Submissions and Protests).

**DATES:** Written comments must be submitted on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

**ADDRESSES:** You may submit comments by any of the following methods:

- *Email:* [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov). Include "0651-0062 comment" in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Marcie Lovett, Records and Information Governance Division Director, Office of the Chief Technology Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal

Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to Raul.Tamayo@upsto.gov with “0651-0062 comment” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

## **SUPPLEMENTARY INFORMATION:**

### **I. Abstract**

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. § 131 *et seq.* to examine an application for patent and, when appropriate, issue a patent. The provisions of 35 U.S.C. §§ 122(c), 122(e), 131, and 151, as well as 37 CFR 1.290 and 1.291, limit the ability of a third party to have information entered and considered in, or to protest, a patent application pending before the Office.

37 CFR 1.290 provides a mechanism for third parties to submit to the USPTO, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application.

A third-party submission under 37 CFR 1.290 may be made in any non-provisional utility, design, and plant application, as well as in any continuing application. A third-party submission under 37 CFR 1.290 must include a concise description of the asserted relevance of each document submitted, and must be submitted within a certain statutorily specified time period.

37 CFR 1.291 permits a member of the public to file a protest against a pending application. Protests pursuant to 37 CFR 1.291 are supported by a separated statutory

provision from third-party submissions under 37 CFR 1.290 (35 U.S.C. § 122(c) v. 35 U.S.C. § 122(e)). As a result, there are several differences between protests and third-party submissions.

For example, 37 CFR 1.291 permits the submission of information in a protest that is not permitted in a third-party submission under 37 CFR 1.290. Specifically, 37 CFR 1.291 provides for the submission of information, including any facts or information adverse to patentability. Further, 37 CFR 1.291 requires a protest to include a concise explanation of the relevance of each item of information submitted. Unlike the concise description of relevance required for a third-party submission under 37 CFR 1.290, which is limited to a description of a document's relevance, the concise explanation for a protest under 37 CFR 1.291 allows for arguments against patentability. Additionally, the specified time period for submitting a protest differs from the time period for submitting third-party submissions, and is impacted by whether the protest is accompanied by the written consent of the applicant.

<b>Comparison</b>	<b>Third Party Submission</b>	<b>Protest</b>
Statute/Rule	35 U.S.C. § 122(e) 37 CFR § 1.290	35 U.S.C. § 122(c) 37 CFR § 1.291
Content	Printed publications	Printing publications and any facts or information adverse to patentability
Remarks	Concise description of relevance (limited to a concise description of each document's relevance)	Concise explanation of the relevance (allows for arguments against patentability)
Timing	Prior to Allowance and prior to later of: 6 months after Pre-Grant Publication or first rejection of any claim	Prior to Allowance and prior to Pre-Grant Publication OR Prior to Allowance and after and after Pre-Grant Publication with application consent

This information collection is necessary so that the public may contribute to the quality of issued patents. The USPTO will use this information, as appropriate, to assist in evaluating the patent application as it moves through the patent examination process.

## **II. Method of Collection**

*OMB Number:* 0651-0062.

*IC Instruments:* PTO/SB/429.

*Type of Review:* Extension of a currently approved collection.

*Affected Public:* Individuals or households; businesses or other for-profits; and not-for-profit institutions.

*Estimated Number of Respondents:* 1,450 responses per year.

*Estimated Time per Response:* The USPTO estimates that it will take the public approximately 10 hours to gather the necessary information, prepare the appropriate form or document, and submit the information to the USPTO.

*Estimated Total Annual Hour Burden:* 14,500 hours.

*Estimated Annual Respondent (Hourly) Cost Burden:* \$6,351,000.00. The USPTO expects that intellectual property attorneys in private firms will complete the instruments associated with this information collection. The professional hourly rate is \$438. The rate is established by estimates in the 2017 Report on the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association. Using this hourly rate, the USPTO estimates that the total respondent cost burden for this collection is \$6,351,000 per year.

**Table 1: Burden Hour and Cost**

IC #	Item	Response Time (hours) (a)	Responses (b)	Annual Burden Hours (c)	Rate (d)	Total Cost (e) (c) x (d)
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				(a) x (b)		
1	Third-Party Submissions in Non-issued Applications (electronic)	10	1,400	14,000	\$438.00	\$6,132,000.00
2	Third-Party Submissions in Non-issued Applications (paper)	10	40	400	\$438.00	\$175,200.00
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291 (paper)	10	10	100	\$438.00	\$43,800.00
	<b>Total</b>		<b>1,450</b>	<b>14,500</b>		<b>\$6,351,000.00</b>

*Estimated Total Annual (Non-hour) Respondent Cost Burden:* \$74,160 per year. There are no capital start-up, recordkeeping or maintenance costs associated with this information collection. There are, however, annual (non-hour) costs associated with this information collection in the forms of filing fees and postage costs. In particular, 37 CFR 1.290 requires payment of the fee set forth in 37 CFR 1.17(o) (\$180 undiscounted; \$90 for a small or micro entity) for every ten documents, or fraction thereof, listed in each third-party submission.

The USPTO provides an exemption from the 1.17(o) fee requirement where a third-party submission listing three or fewer total documents is the first third-party submission submitted in an application by the third party, or a party in privity with the third party. The effect of this is that the first three documents submitted by a third party are exempt from the fee requirement. However, the submission of four or more documents by a third party triggers the collection of the fee.

There is no fee for filing protests under 37 CFR 1.291 unless the filed protest is the second or subsequent protest by the same real party in interest, in which case the 37 CFR 1.17(i) fee of \$130 must be included. The USPTO estimates that only 1 out of every 10 protests filed per year will require this fee.

When electronically submitting the information in this collection to the USPTO, the applicant is encouraged to retain a copy of the file submitted to the USPTO as

evidence of the application. Inclusion of an USPS acknowledgement receipt with mailed items provides evidence of the date the file was received by the USPTO. The USPTO does not, however, require this recordkeeping, and thus does not consider this action to be a recordkeeping cost imposed on the applicant.

**Table 2: Filing Fees**

IC #	Item	Estimated Annual Responses (a)	Filing fee (\$) (b)	Total Non-hour Cost Burden (\$) (a) x (b) = (c)
1-2	Third-Party Submissions in Non-issued Applications	410	\$180.00	\$73,800.00
1-2	Third-Party Submissions in Non-issued Applications (small and micro entities)	170	\$90.00	\$15,300.00
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291	1	\$130.00	\$130.00
	<b>Total</b>	<b>581</b>		<b>\$73,930.00</b>

This collection also has non-hourly annual cost burden in the form of postage costs. Customers may incur postage costs when submitting the instruments contained within this collection to the USPTO by mail through the United States Postal Service. The USPTO estimates that the average first class postage cost for a one-pound submission mailed in a flat-rate envelope to be \$6.70. The USPTO estimates that the vast majority – roughly 98 percent – of all paper submissions will be delivered by mail, with the remainder being delivered by hand delivery, for an estimated that approximately 40 submissions will require postage. Therefore, the estimated postage cost for this collection will be \$268.

The total non-hour respondent cost burden for this collection in the form of filing fees (\$73,930) and postage costs (\$268) is approximately \$74,198.

#### **IV. Request for Comments**

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection. They will also become a matter of public record.

Comments are invited on:

- a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility;
- b) The accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information;
- c) Ways to enhance the quality, utility, and clarity of the information to be collected; and
- d) Ways to minimize the burden of the collection of information on respondents, e.g., the use of automated collection techniques or other forms or information technology.

**Marcie Lovett,**

*Records and Information Governance Division Director, OCTO,*

*United States Patent and Trademark Office.*

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